

### REMARKS

These remarks are directed to the office action mailed May 16, 2008, setting a three month shortened statutory period for response which expired on August 16, 2008. A three month extension request and required fee authorization accompanies this amendment to reset the period so as to expire on November 16, 2008. The office action issued by the Examiner and the citations referred to in the office action have been carefully considered.

Prompt reconsideration is requested in view of the above claim amendments and the following remarks. As indicated, amendments introduce no new matter. Claims 18-19 have been cancelled. Claims 10, 12, 13, 15-17, and 20 are pending.

### Claim Rejections - 35 USC § 103

Claims 10, 13, and 15 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over the process disclosed within the instant Background of the Invention in view of any of Baskin (US Pat 4,956,030), Yukawa et al. (US Pat 5,568,508) and United Kingdom reference 1,127,296 (UK '296). Claims 12 and 15 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over the process disclosed within the instant Background of the Invention in view of any of Baskin, Yukawa et al., UK '296 and further in view of any of Orsini, Rostoker, Sakai, and Hoesch and further in view of either of Lemelson and Ballhausen.

The Applicant respectfully submits that the process disclosed within the instant Background of the Invention relates to a different field of agglomerate stone formation than cited references Baskin, Yukawa, and UK '296. Prior to the polyethylene-coated (PE) paper grinding step, the instant Background of the Invention discloses **a vibration and vacuum pressing process that results in an antique-look surface** having natural looking irregularities, ridges, depressions, and cracks. The cited references all teach a **pressure-rolling process** that eliminates irregularities, ridges, depressions, and cracks **to yield a high-gloss, smooth surface**. Though Baskin teaches that the pressure-rolled film may be embossed with a pattern, an embossed patterned surface is still distinctly different from a surface with natural looking irregularities that are **unique for each formed agglomerate slab**. There is no motivation for

one skilled in the art to combine the teachings of art that deal with the formation of irregular and individually unique antique-look surfaces with the cited references that deal with the formation of identical, high-gloss surfaces.

KSR Applies to the Instant Application

The Applicant submits that there is no teaching, suggestion, motivation test promulgated by United States Court of Customs and Patent Appeals and adopted by the Federal Circuit. *Application of Bergel*, 292 F.2d 955, 956-957, 48 C.C.P.A. 1102, 1961 Dec. Comm'r Pat. 504 (1961). The Applicant recognized, however, that the current authority on matters of obviousness must square with the Supreme Court's recent decision in *KSR Int'l v. Teleflex, Inc.*, 127 S. Ct. 1727, 82 U.S.P.Q.2d 1385 (2007). Accordingly, although the teaching, suggestion, motivation test is still recognized under *KSR*, the test is largely subsumed by the more general principles laid out in *KSR*. Indeed, in any given application, the combination of elements "must do more than yield a predictable result." *Id.* at 1740. Nevertheless, combining elements "in an unexpected and fruitful manner" is sufficient to render an invention non-obvious. *Id.*

Any Teaching or Combination of References Used by the Examiner is Improper

*KSR* provides guidance with respect to the combination of references used to reject a patent application on the ground of obviousness. According to *KSR*: "Although **common sense** directs one to look with care at a patent application that claims as innovation the combination of two known devices according to their established functions, **it can be important to identify a reason** that would have **prompted** a person of ordinary skill in the relevant field **to combine the elements** in the way the claimed new invention does." *KSR* at 1741 (emphasis added).

More importantly, "a patent composed of several elements **is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art.**" *Id.* (emphasis added).

In *KSR*, the Supreme Court addressed such logic in obviousness-type rejections. Importantly, *KSR* specifically forbids obviousness rejections simply because each element was

independently known in the prior art. The art cited against the instant application falls into this rubric because they are nothing more than a string of unrelated references showing each of the claimed elements with tenuous logic to support their combination.

The Examiner has failed in his burden to explain any compelling reason why a person of ordinary skill would have combined these references.

No Reasonable Expectation of Success Can Be Inferred from the Combination of References Asserted by the Examiner

Reasonable Expectation Standard Reaffirmed Post-KSR

The Federal Circuit stated “obviousness does not require absolute predictability of success . . . [a]ll that is required is a reasonable expectation of success.” *In re O’Farrell*, 853 F.2d 894, 903-04; 7 U.S.P.Q.2d 1673 (Fed. Cir. 1988). Thus, if a reasonable expectation of success is derived from a reference or combination of references, an invention may be rendered obvious. Conversely, where no reasonable expectation of success is derived, an obviousness rejection is improper. *Id.*

More specifically, *O’Farrell* provides general guidance as to when an invention falls under the reasonable expectation of success rubric, which was subsequently reaffirmed by the Federal Circuit post-KSR in *Pharmastem Therapeutics, Inc. v. Viacell, Inc.*, 491 F.3d 1342, 1364; 83 U.S.P.Q.2d 1289 (Fed. Cir. 2007). According to the Federal Circuit, “an invention would not be invalid for obviousness if the inventor would have been motivated ‘to **vary all parameters or try each of numerous possible choices until one possibly arrived at a successful result**, where the **prior art gave either no indication** of which parameters were critical or **no direction** as to which of many possible choices is likely to be successful.’” *Id.* at 1364, quoting *Medichem, S.A. v. Rolabo, S.L.*, 437 F.3d 1157, 1165, 77 U.S.P.Q.2d 1865 (Fed. Cir. 2006) (emphasis added).

In a secondary test posited by the Federal Circuit in *Pharmastem*, the court stated “[l]ikewise, an invention would **not be deemed obvious if all that was suggested** ‘was to

**explore a new technology or general approach** that seemed to be a **promising field of experimentation**, where the **prior art gave only general guidance** as to the particular form of the claimed invention or how to achieve it.” *Id.*, quoting *Medichem, S.A. v. Rolabo, S.L.*, 437 F.3d 1157, 1165, 77 U.S.P.Q.2d 1865 (Fed. Cir. 2006) (emphasis added).

No Reasonable Expectation of Success Where Numerous Possible Choices or Requirement to Vary All The Parameters

Using the first of the standards promulgated by the Federal Circuit, the combination of references cited by the Examiner against the claims have no reasonable expectation of success because the prior art references give no indication of critical parameters or direction as to how to achieve the claimed invention. Using any one of the prior art as the starting point to arrive at the claimed references cited against the instant application would require numerous choices in direction and experimentation, as well as variance of many parameters to arrive at the claimed invention.

For the reasons stated above, the prior art references cited against the claims also fail the second standard promulgated by the Federal Circuit. An invention is not obvious if all that was suggested is to explore a new technology or general approach that seemed to be a promising field of experimentation, where the prior art gave only general guidance as to the particular form of the claimed invention or how to achieve it. *Pharmastem* at 1364. In other words, the combination of references must give specific guidance to arrive at the claimed invention.

More specifically, the prior art references cited against the instant claims include references directed to different fields. These prior art references alone give no more than general guidance to the instant problem and claimed solution, and arguably do not give any guidance whatsoever.

In fact, the combination of these references makes sense **only** when viewed in the context of the specification and claims. Alone, they don't get a person of ordinary skill in the art any closer to an expectation of success because they simply don't have enough guidance, even when

combined, to guide a person of ordinary skill in the art to the claimed result without significant detective work.

Claims 10 and 16 have been amended to clarify that a vibration and vacuum pressing step is used to obtain an antique-look surface having irregularities, ridges, depressions, and cracks.

The Applicant further submits that the Background of the Invention does not disclose the deliberate and non-obvious step of polishing the panel to “render the panel less porous, thereby reducing corrosion and dirt penetration”, while retaining irregularities, ridges, depressions, cracks, and microcracks that provide a more antique-look to the surface. **Polishing is usually performed to impart a gloss and remove irregularities on a smooth surface.** Surfaces with an antique or aged-look, with irregularities, small cavities, protuberances, as well as cracks and microcracks, normally do not desire a polished high-gloss. Therefore, without relying on Applicant’s teachings of a subsequent polishing step, simply detaching the PE paper following the vibration and vacuum pressing process disclosed in the Background of the Invention would yield a surface that:

“...is extremely porous, tending to retain liquid and dust residues present in the environment, with inevitable periodic build-ups of dirt...this porosity accelerates corrosive phenomena which, over time, cause the sheet made of agglomerate material to break.” (page 3, lines 8-13)

The polishing step as claimed by Applicant in claims 10 and 16 serves a non-obvious function that is not taught in the Background of the Invention. The purpose and advantage of polishing in the invented method is to reduce corrosion and dirt penetration, not to remove irregularities or impart a high-gloss (see claim 16).

Applicant submits that the cited references relate to different fields of art and that there is no motivation for combining the teachings of these different fields of art. It is not obvious to one skilled in the art of creating unique, antique-look surfaces to substitute with processes used in the art of creating identical, high-gloss surfaces. Therefore independent claims 10 and 16 and the

claims thereby dependent therefrom are patentable under 35 USC §103. The Examiner is respectfully requested to reconsider and now withdraw the Examiner's rejection.

**Conclusion**

In view of the above, it is respectfully submitted that this application is now in good order for allowance, and such early action is respectfully solicited. Should matters remain, which the Examiner believes could be resolved in a telephone interview, the Examiner is requested to telephone Applicant's undersigned attorney.

The Director is authorized to charge any additional fee(s) or any underpayment of fee(s), or to credit any overpayments to **Deposit Account Number 50-2638**. Please ensure that Attorney Docket Number 058009-019000 is referred to when charging any payments or credits for this case.

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Respectfully submitted,



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